

REMARKS

At the outset, Applicants thank the Examiner for extending her time and giving thoughtful consideration to the pending claims and the proposed amendments during the July 30, 2003 telephone interview. Applicants sincerely appreciate the courtesy. Reconsideration of the prior rejections is requested in light of the foregoing amendments and following remarks.

Status of the Claims/Amendments

Applicants have added new claim 10, and thus claims 1 and 10 are now pending in the application. Claim 1 was rejected by the April 9, 2003 Office Action under 35 U.S.C. §102(a) as allegedly being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as allegedly being obvious over Applicant's Prior Art Admission.

Applicants have amended claim 1 to further recite "passing the peeled sheet of nonwoven fabric through tension adjust rolls." This amendment is supported by, for example, the description at page 12, lines 16-26 as well as Fig. 1 of the specification. Applicants also have added a new claim 10 which is directed to a thermoplastic elastomer fabric roll. This amendment is supported by the description through the whole specification, more particularly by Examples 1-5 of the specification. No new matter has been added by the amendments presented herein.

35 U.S.C. §102/103 Rejection

The rejection against claim 1 under 35 U.S.C. §102(b) as allegedly being anticipated by, or alternatively under 35 USC §103(a) as being obvious over Applicant's Prior Art Admission is newly introduced in the Office Action mailed April 9, 2003.

Applicants have amended claim 1 by further reciting "passing the peeled sheet of nonwoven fabric through tension adjust rolls," and such limitation is neither taught nor suggested by the prior art relied upon by the Examiner in the Office Action.

As the Office Action recognizes, the prior art described in the specification is shown as Fig. 9. Also, the specification shows experimental results of comparison between the claimed

invention and the prior art (i.e., "Comparative Example 1"). Applicants respectfully note that Table 1 in page 18 of the specification explicitly shows the prior art does not teach the claimed property of the required tension to unroll the non-woven roll (i.e., 0.25 g/cm/basis-weight or less). In fact, the nonwoven fabric roll of Comparative Example 1 (i.e., prior art shown as Fig. 9) shows the tension of 0.35 g/cm/basis-weight.

Accordingly, Applicants believe that claim 1 is patentably distinct from the art of record.

New Claim 10

Applicants have added new claim 10 as follows:

10. A thermoplastic elastomer nonwoven fabric roll consisting of a sheet of nonwoven fabric made of thermoplastic elastomer filaments, the sheet of nonwoven fabric being wound around a tube thereby forming the nonwoven fabric roll and

wherein a tension required to unroll the sheet of nonwoven fabric from the nonwoven fabric roll is 0.25 g/cm/basis-weight or less.

Applicants respectfully point out that the new claim 10 expressly recites the limitation "a tension required to unroll the sheet of nonwoven fabric from the nonwoven fabric roll is 0.25 g/cm/basis-weight or less." As stated above, the nonwoven fabric roll of the prior art described in the specification (Comparative Example 1) shows the tension of 0.35 g/cm/basis-weight.

The cited reference simply does not teach, disclose or suggest a tension required to unroll of "0.25 g/cm/basis-weight or less" as recited in Applicants' independent claim 10.

Moreover, the principal of inherency cannot cure this deficiency. For inherency to apply, the missing descriptive matter must necessarily be present in the thing described in the reference. Inherency may not be established by probabilities or possibilities. In re Robertson, 49 U.S.P.Q. 2d 1949, 1950 (Fed. Cir. 1999); Bronshtein v. Roser, 61 U.S.P.Q. 2d 1745, 1755 (B.P.A.I. 2002) (unpublished); MPEP § 2112. Such burden of proof has not, and cannot be met, where Comparative Example 1 shows that cited reference results in a tension outside of the claimed range.

During the interview, the Examiner suggested that a product claim having a functional point of novelty may give rise to concerns under 35 U.S.C. § 112 for a lack of written description etc. Particular reference was made to *Ex parte Slob*, 157 U.S.P.Q. 172 (BPAI 1968), which holds that "language purport[ing] to cover everything which will perform the desired functions regardless of its composition" renders the claims "invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in the future and which would impart the desired characteristics." *Id.* at 173.

However, *Ex parte Slob* does not appear to be an appropriate rationale for making a rejection. The MPEP "outlines the current procedures which the examiners are required or authorized to follow." *See* MPEP (8th ed. rev. 1) at Forward (emphasis added). However, the holding in *Ex parte Slob* has not been incorporated, to Applicants' knowledge, anywhere within the MPEP. Accordingly, Applicants believe that claim 10 cannot be rejected on the basis of *Ex parte Slob*.

Further, Applicants respectfully point out that functional language does not, in and of itself, a claim indefinite or improper under 35 U.S.C. § 112. *See* MPEP § 2173.05(f) ("There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself render a claim improper") (*citing In re Swinehart*, 439 F.2d 210, 169 U.S.P.Q. 226 (CCPA 1971)). Further still, to the extent that *Ex parte Slob* conflict with *In re Swinehart*, the later should control.

For at least these reasons, claim 10 is believed to be patentably distinct. Allowance is requested.

Appl. No.: 09/595,241

Docket No. 3620-4006

Paper dated August 11, 2003

Reply to Office Action dated April 2, 2003

CONCLUSION

For the above-stated reasons, this application is respectfully asserted to be in condition for allowance. An early and favorable examination on the merits is requested. In the event that a telephone conference would facilitate the examination of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE ANY ADDITIONAL FEES WHICH MAY BE REQUIRED FOR THE TIMELY CONSIDERATION OF THIS AMENDMENT UNDER 37 C.F.R. §§ 1.16 AND 1.17, OR CREDIT ANY OVERPAYMENT TO DEPOSIT ACCOUNT NO. 13-4500, ORDER NO. 3620-4006.

Respectfully submitted,
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By: _____

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